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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/537,871

07/27/2005

Thomas Goebel

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6784

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7590

11/24/2008

Novartis Animal Health US Inc.  
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EXAMINER

SCHLENTZ, NATHAN W

ART UNIT

PAPER NUMBER

1616

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/537,871	<b>Applicant(s)</b> GOEBEL ET AL.	
	<b>Examiner</b> Nathan W. Schlientz	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-36 is/are allowed.
- 6) ☒ Claim(s) 19, 20, 23, 24 and 37 is/are rejected.
- 7) ☒ Claim(s) 21, 22 and 25-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of the Claims***

Claims 23, 29, 30 and 37 were amended in an amendment filed 04 August 2008. As a result, claims 19-37 are examined herein on the merits for patentability.

### ***Withdrawn Rejections***

Rejections and/or objections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 20 states that R is branched C<sub>1</sub>-C<sub>9</sub> alkyl. However, it is unclear how C<sub>1</sub> and C<sub>2</sub>, which are encompassed by this range, can be branched.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Suzusho et al. (JP 48-042279).

Suzusho et al. disclose impregnating wet fabric with an aqueous solution of N,N-bis(methoxymethyl)acetamide (Abstract; Examples 2-4). Therefore, Suzusho et al. disclose a composition comprising N,N-bis(methoxymethyl)acetamide in water.

It is noted that the recitation of the intended use “vermin-repellent” has not been given patentable weight to distinguish over Suzusho et al. because the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Since Suzusho et al. disclose compositions that are the same as those claimed, in the absence of evidence to the contrary they would be capable of performing the intended use, as claimed.

2. Claims 19, 23, 24 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Mod et al. (US 3,515,754).

Mod et al. disclose compositions comprising N,N-disubstituted amides, such as N,N-bis(2-ethoxyethyl)palmitamide, N,N-bis(2-ethoxy)-2-ethylhexanamide, and N,N-bis(2-ethoxyethyl)decanamide (Examples 2, 4 and 10). Mod et al. disclose that the compounds are prepared in benzene and worked up in hexane (Example 1). The instant specification lists benzene and hexane as suitable diluents (pg. 6, ln. 1-11).

Mod et al. disclose preparing N,N-bis(2-ethoxyethyl)palmitamide by reacting di(2-ethoxyethyl)amine and palmitic acid (Example 2). Mod et al. also disclose preparing N,N-bis(2-ethoxyethyl)-2-ethylhexanamide by reacting di(2-ethoxyethyl)amine and 2-ethylhexanoyl chloride (Example 4). Mod et al. also disclose preparing N,N-bis(2-ethoxyethyl)decanamide by reacting di(2-ethoxyethyl)amine and capric acid (Example 10).

It is noted that the recitation of the intended use “vermin-repellent” has not been given patentable weight to distinguish over Mod et al. because the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Since Mod et al. discloses compounds that are the same as those claimed, in the absence of evidence to the contrary they would be capable of performing the intended use, as claimed.

### ***Response to Arguments***

Applicants argue on page 5 that Mod et al. is not directed to vermin-repellent compositions and further do not teach diluents or spreading additives necessary for such veterinary compositions, as instantly claimed.

However, the examiner respectfully argues that Mod et al. disclose N,N-bis(2-ethoxyethyl)palmitamide, N,N-bis(2-ethoxy)-2-ethylhexanamide, and N,N-bis(2-ethoxyethyl)decanamide prepared in benzene and worked up in hexane (Examples 1, 2, 4 and 10); and the instant specification lists benzene and hexane as suitable diluents (pg. 6, ln. 1-11). With respect to the intended use as a vermin-repellent, the examiner respectfully argues that the recitation of intended use has not been given patentable weight, as discussed above. Mod et al. disclose compositions that have the same components as the composition as instantly claimed, and thus anticipates the instantly claimed composition.

3. Claims 19, 23 and 24 rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,712,926 (Petersen).

Petersen discloses compositions comprising N,N-disubstituted amides, such as N,N-dimethoxymethylacetamide and N,N-dimethoxymethylpropionamide (Examples 1 and 3). Peterson discloses that the compounds are prepared in excess methanol and water (Examples 1 and 3), which are diluents.

It is noted that the recitation of the intended use “vermin-repellent” has not been given patentable weight to distinguish over Petersen because the intended use of the claimed invention must result in a structural difference between the claimed invention

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and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Since Petersen discloses compounds that are the same as those claimed, in the absence of evidence to the contrary they would be capable of performing the intended use, as claimed.

### ***Response to Arguments***

Applicants argue on page 6 that Peterson does not teach or even suggest diluents or spreading additives necessary for veterinary compositions as instantly claimed, and further do not remotely teach a vermin-repellent composition.

However, the examiner respectfully argues that Petersen discloses compositions comprising N,N-disubstituted amides, such as N,N-dimethoxymethylacetamide and N,N-dimethoxymethylpropionamide (Examples 1 and 3) that are prepared in excess methanol and water (Examples 1 and 3), which are diluents. With respect to the intended use as a vermin-repellent, the examiner respectfully argues that the recitation of intended use has not been given patentable weight, as discussed above. Peterson discloses compositions that have the same components as the composition as instantly claimed, and thus anticipates the instantly claimed composition.

***Allowable Subject Matter***

Claims 21, 22 and 25-28 are objected to as being dependent upon a rejected base claim (claim 19), but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 29-36 are allowed.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan W. Schlientz whose telephone number is 571-272-9924. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWS

/John Pak/  
Primary Examiner, Art Unit 1616